

April 5, 2005  
Case No.: AUS920010930US1 (9000/85)  
Serial No.: 10/004,924  
Filed: December 5, 2001  
Page 6 of 10

**-- REMARKS --**

Claims 1-19 remain under consideration, and claim 20 has been added without adding any new matter. Applicant thanks the Examiner for his several courtesies in the interview of March 28, 2005, and appreciates the progress made in that interview.

**A. Claims 4, 8, and 19 were rejected under 35 U.S.C. §112**

Claims 4, 8, and 19 have been amended in a non-statutory amendment to correct typographical errors, and not to avoid any reference. Withdrawal of the rejections to claims 4, 8, and 19 is requested.

**B. Claims 1, 2, 4-9, 11-13, 15-19 were rejected under 35 U.S.C. §103(a) as unpatentable over Sitbon in view of Lebow**

The §103(a) rejections of claims 1, 2, 4-9, 11-13, and 15-19 as unpatentable over Sitbon in view of Lebow is traversed. In order to sustain the rejection, each and every element of the claimed invention must be taught or suggested by the references, alone or in combination, in at least as great detail as claimed. Since the references do not teach or suggest each and every element, the rejection should be withdrawn.

At a minimum, Sitbon in view of Lebow does not teach or suggest "accessing the stored return code from an application program," as claimed in claims 1, 9, and 12. The Examiner's reliance on Lebow column 11, lines 52-57 is misplaced. Lebow teaches away from accessing the stored return code from an application program, by teaching that a "test operator can examine the log file generated upon execution of a test script to identify possible discrepancies between returned an expected results." Column 11, lines 55-57. Thus, Lebow teaches that a human examines the log file rather than accessing the stored return code from an application program.

April 5, 2005  
Case No.: AUS920010930US1 (9000/85)  
Serial No.: 10/004,924  
Filed: December 5, 2001  
Page 7 of 10

Furthermore, in order to maintain this rejection, the Examiner must point to some motivation for such a combination. Such motivation may be express or implicit. In this case, where there is no express teaching to combine, the Examiner must be relying on an implicit rationale, but makes no evidentiary showing of any such motivation. Merely arguing that a combination would "improve the system of Sitbon..." (1/6/05 Office Action, p. 4, para. 12) fails to satisfy the strictures of §103. First, the Examiner makes no showing of the level of skill possessed by one of ordinary skill in the art, and further, the Examiner makes no showing that the Examiner is relying on common knowledge. See MPEP §§2144 and 2144.03. There is no suggestion, express or implied, in the prior art to make such a combination. Therefore, the §103(a) rejection of claims 1, 9, and 12 must fall for at least this additional reason.

Even assuming that the references teach each element of the claimed invention, the prior art must suggest the desirability of the claimed invention – without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998), MPEP §2143.01. There are three sources for such a motivation – the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *Id.* In this case, as the prior art does not teach the desirability of a combination, the Examiner has relied on a statement that "it would have been obvious" and so appears to be relying on either the nature of the problem or the knowledge of persons of ordinary skill in the art. However, the level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999) and MPEP §2143.01. And, since the Examiner does not identify the nature of the problem to be solved, the Examiner has no support for this §103(a) rejection.

April 5, 2005  
Case No.: AUS920010930US1 (9000/85)  
Serial No.: 10/004,924  
Filed: December 5, 2001  
Page 8 of 10

It is settled that the rationale supporting an obviousness rejection may be based on common knowledge in the art, but it is also settled that the motivation to combine the references cannot come from the knowledge of persons of ordinary skill in the art. See, MPEP §§2143.01, 2144.03. The Examiner has not taken official notice of any facts outside of the record, nor provided an Examiner's affidavit/declaration supporting the level of skill in the art. Furthermore, allegations concerning specific knowledge of the prior art which might be peculiar to a particular art should also be supported, and assertion of a technical fact in an area of esoteric technology, such as the Examiner's assertions herein, *must always be* supported by citation of some reference work. MPEP §2144.03. Applicant traverses the "well known" statement.

Additionally, Sitbon in view of Lebow unequivocally teaches away from the "return code file is created by the command script" as claimed in claim 2 at column 11, lines 52-56 of Lebow, where Lebow teaches that the log file is generated *and* examined by the interpreter 54. In claim 2, the return code file is created by the command script, and the stored returned code is accessed from an application program. Furthermore, Sitbon teaches that the application monitors the execution of the scripts which it has activated by manipulating objects and their attributes at column 3, lines 1-3. Therefore, claim 2 is allowable over the prior art for at least this additional reason.

Therefore, independent claims 1, 9, and 12 are patentable over Sitbon in view of Lebow, as are claims 2, 4-8, 11-13, and 15-19, depending from claim 1, 5, or 9 respectively. Withdrawal of the rejections to claims 1, 2, 4-9, 11-13, and 15-19 is requested.

April 5, 2005  
Case No.: AUS920010930US1 (9000/85)  
Serial No.: 10/004,924  
Filed: December 5, 2001  
Page 9 of 10

**C. Claims 3, 10 and 14 were rejected under 35 U.S.C. §103(a) as unpatentable over Sitbon in view of Lebow in further view of Agarwal**

The §103(a) rejection of claims 3, 10, and 14 is traversed. Claims 3, 10, and 14 depend from claims 1, 9, or 12 respectively, and are therefore patentable over the prior art for at least the same reasons.

Additionally, each of claims 3, 10, and 14 require "verifying the existence of the return code file, prior to accessing the stored return code," which is not taught or suggested by Sitbon in view of Lebow in view of Agarwal. The Examiner's reliance on column 2, lines 37-41 is misplaced, as that section only teaches that "issuing of an early warning can also include, but is not limited to, writing an early warning log entry into a log file, which can be periodically checked by a human or by a processor." Agarwal does not teach verifying the existence of the return code file, prior to accessing the stored return code. Claims 3, 10, and 14 are patentable over the prior art for at least this additional reason.

Withdrawal of the rejections to claims 3, 10, and 14 is requested.

**D. New claim 20**

New claim 20 depends directly from claim 1 and is therefore patentable over the prior art for at least the same reasons as claim 1.

April 5, 2005  
Case No.: AUS920010930US1 (9000/85)  
Serial No.: 10/004,924  
Filed: December 5, 2001  
Page 10 of 10

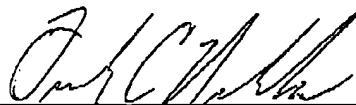
**CONCLUSION**

The Applicants respectfully submit that claims 1-20 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. In view of the foregoing, favorable consideration and early passage to issue of the present application is respectfully requested.

Dated: **April 5, 2005**

Respectfully submitted,  
JAMES M. MCARDLE

CARDINAL LAW GROUP  
Suite 2000  
1603 Orrington Avenue  
Evanston, Illinois 60201  
Phone: (847) 905-7111  
Fax: (847) 905-7113



---

Frank C. Nicholas  
Registration No. 33,983  
Attorney for Applicants